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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/107,643	06/30/98	TRACY R	TRAC-100FWC-

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EXAMINER	
POLUTTA, M	
ART UNIT	PAPER NUMBER
3761	16

DATE MAILED: 01/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/85)

1- File Copy

Office Action Summary

Application No.	Applicant(s)
09/107,643	Tracy
Examiner	**Group Art Unit**
M. Pidlaha	3761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 10/25/99.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 7-10 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 7-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 13

☐ Interview Summary, PTO-413

☐ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The term "soft" in claim 7 is a relative term which renders the claim indefinite. The term "soft" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Foreman (US Pat. 4,816,025).

Foreman teaches to provide a standard hourglass shape diaper (Fig. 1) having a plastic outer layer (col. 8, lines 43-47) and a liquid absorbent layer (col. 7, lines 41-56).

Foreman also teaches to provide a separate second barrier cuff 262 formed adjacent to the outer plastic layer along the waistband of the diaper to provide a soft edge to the wearer preferably made of a variety of soft materials (col. 5, lines 17-60; col 11, lines 1-12.) Foreman states "the second distal edge 266 is preferably formed as above so as to present a soft non-jagged edge to the wearer." (5:56-58)

5. To the extent that applicant may argue that the cuff of Foreman is not a "soft padding member" the following rejection is additionally being made.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foreman in view of Lindquist (US Pat. 3,572,342).

Foreman discloses the invention as claimed except for the express provision of a "padding member."

Lindquist teaches in the same field of endeavor to provide padding elements '37 and '38 made of foam applied along the portion of the diaper at which seepage of fluids is not desired along the upper surface of a diaper.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the upper surface of end cuffs 262 of Foreman with padding elements made of foam in order to retard fluid. (See 1:15-20)

8. Claims 7-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McConnell et al (3,461,872).

McConnell discloses a diaper retaining garment (Fig. 1) including an absorbent pad (26 and 27) (Figs. 5 & 6). The body includes two enlarged end portions, a narrowed intermediate portion, a waist band portion at each end (see the end portions), at least two body portion layers including a layer of liquid absorbent material (26 & 27) and a plastic layer having an edge at the edge of the diaper (the body portion 10 of a flexible polymeric cellular material, an opened celled foam such as polyurethane is a plastic layer and the elastic strip 21 is also considered to be a plastic material) and a soft padding member (22) located along at least one of the waistband portions adjacent the plastic edge, so that the soft substance is located between the diaper wearer and the plastic layer edge, such that the diaper presents a soft surface at the waistband portion despite the plastic edge.

McConnell discloses:

> The elasticized edges 11, 12, 18 and 19, are preferably covered by fabric outer strip 22 to prevent contact of the wearer with the elastic material forming strip 1. This strip 22 is sewn on along with the elasticized strip 21 and forms an envelope around it. The details of this construction feature can clearly be seen from Figure 2. The material forming the outer strip 22 may comprise any type of flexible material but is preferably a woven fabric or scrim." (3:30-39)

The outer strip 22 wraps around the elastic (21) and the body (10), thus it inherently presents a soft surface or a non-abrasive surface at the waistband portion. According to Webster's Dictionary "scrim" is usually a cotton fabric. Also, McConnell states the elasticized edges are covered by a fabric outer strip 22 to prevent contact of the wearer with the elastic material, thus it is inherently a soft material. If it is not inherent, that the material is soft and nonabrasive, then it would have been obvious to one of ordinary skill in the art at the time the invention was made because it is well recognized that babies skin is soft and easily irritated. Why else would McConnell cover the elastic strip with a fabric to prevent contact of the wearer with the elastic. One of ordinary skill would not cover an elastic with a hard or abrasive material as it defeats the purpose of covering it. Regarding claims 9 and 10, the strip or soft padding member extends from the inside to the outside of the diaper.

Additionally, it is noted that applicant's declaration states that the cotton around the waistline and leg lines of the diaper is a very fine, small layer of cotton, which would be very similar, but not exactly the same as that of a gauze pad or the inside of a gauze pad. McConnell discloses the use of a "woven fabric or scrim", which is essentially the same thing.

Claim Rejections - 35 U.S.C. § 101

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 7-10 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 5,064,421 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

11. Claims 7-10 are rejected under the judicially created doctrine of double patenting over the claims 1-15 of U. S. Patent No. 5,797,824 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Amendment

12. The declaration filed on February 2, 1999 under 37 CFR 1.131 has been considered but is ineffective to overcome the Foreman reference.

13. The Foreman reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131.

It is noted that applicant demonstrates in the evidence supporting her declaration that the cotton around the waistline and leg lines of the diaper are a very fine, small layer of cotton which would be very similar, but not exact to that of a gauze pad or inside of a gauze pad.

Response to Arguments

14. Applicant's arguments filed October 25, 1999 have been fully considered but they are not persuasive.

Applicant can not swear behind a 102(b) reference. Foreman is a 201(b) reference because applicant can only rely on the filing date of the earlier filed design application (07/93,681) for what the application teaches. Since the design application does not provide support for the material along the edge of the waistband being a soft padding member and Foreman was filed more than a year before the filing date of the 07/516,473 application, it is a 102(b) reference. See In re Chu, 36 USPQ 2d. 1089 at 1093 (CAFC). "It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure the earlier application provides support for the claims of the later application, as required by 35 U.S.C. §112." The design application does not provide support for the claimed invention, so applicant can not rely on the design application for it's filing date and thus swear behind the reference. The design application does not teach that the material along the edge of the waistband is a soft padding member distinct from the body

portion layer to present a soft surface at the inside of the diaper waistband portion to the wearer or a strip of non-abrasive material located along the waistband portion to provide a cushioned surface at the inside of the diaper waistband portion to the wearer. Muchless, does the design application provide support for the material comprising a cotton material around the waistline and leg lines of the diaper that are a very fine, small layer of cotton which would be very similar, but not exact to that of a gauze pad or inside of a gauze pad.

15. Regarding McConnell, the BPAI has not considered the McConnell reference as it is now being applied.

16. Regarding the double patenting rejection, applicant may file a supplemental terminal disclaimer stating that the person has 100% or the whole interest.

17. Applicant's representative argues that Foreman's cuff (262, 266) is a barrier cuff and prevents waste from escaping, thus it is not a soft padding member, as it is not soft, however, Foreman specifically states that it is soft (See 5:56-60) and that it presents a soft nonjagged edge to the wearer.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). While Lindquist does not teach applying barriers along the waistband, Foreman does teach placing barriers along the waistband.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schaar (3,995,638) teach a diaper with an elastic waistband wherein the material is folded back over the elastic, thus providing padding. Buchalter (3,896,807) and Duncan (3,489,187) both discuss treatments for diaper to prevent diaper rash and chafing of the babies skin.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information Disclosure Statement

20. The information disclosure statement filed July 2, 1999 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). However, since applicant has authorized payment of the fee, the IDS has been considered.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark O. Polutta whose telephone number is (703) 308-2114.

The examiner's supervisor, John Weiss, telephone number is (703) 308-2702. The fax phone number for official papers for this Group is (703) 305-3590. The fax phone number for unofficial papers for this Unit is (703) 306-4520.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Mark O. Polutta
January 11, 2000

MARK O. POLUTTA
PRIMARY EXAMINER
SECTOR 3700